IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yonas D. Seme

Application No.: 10/035,085   Confirmation No.: 3973

Filed: December 28, 2001   Art Unit: 2626

For: METHOD AND SYSTEM FOR   Examiner: J. R. Jackson
       TRANSLATING INSTANT MESSAGES

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under 37 C.F.R. § 41.37(a), this brief is in furtherance of said Notice of Appeal in this application filed on August 7, 2008. The fees required under 37 C.F.R. § 41.20(b)(2), and any required petition for extension of time for filing this brief and associated fees, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

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I.   REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation of Redmond, Washington.

II.   RELATED APPEALS AND INTERFERENCES

Neither appellant, nor appellant's legal representative, nor assignee is aware of any other prior or pending appeals, interferences, or judicial proceedings that may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal.

III.   STATUS OF CLAIMS

Claims 1-58 have been presented. Claims 1-36 and 43-47 have been canceled during prosecution. Claims 37-42 and 48-58 are presently pending and rejected.

Claims 37-42 and 48-58 are the subject of the present appeal. The text of these claims is set forth below in the Claims Appendix.

IV.   STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Office Action dated May 7, 2008.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

A.   Appellant's Technology

In one embodiment, appellant's technology translates instant messages exchanged between a first user using a first device and a second user using a second device. For example, as illustrated in Figures 5A and 5B of appellant's specification, appellant's technology translates instant messages exchanged between a user of a source device 200 having a first translation preference 214 (e.g., Swahili) and a user of a destination device 202 having a second language preference 216 (e.g., English). During initiation of an instant messaging session, the source device 200 and the

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destination device 202 exchange translation preferences. The source device 200 sends an indication of the first translation preference 214 to the destination device 202 and receives from the destination device 202 an indication of the second translation preference 216. When the user of the source device 200 composes a message, the source device 200 translates the message from the first translation preference 214 to the second translation preference 216 and transmits the translated message to the destination device 202. Because the source device 200 translates the message before transmitting it to the destination device 202, the second user receives the message in the second translation preference 216 and does not need to translate the message.

In another embodiment, appellant's technology allows a first device (e.g., source device 200 in Figure 5B) to translate received messages from a translation preference of a second user using a second device (e.g., destination device 250) to the translation preference of a first user, and vice versa. Because the first device performs the translation in both directions (i.e., to and from the translation preference of the second user), the second device, which may not be computationally powerful, need not incur the translation overhead.

In another embodiment, appellant's technology translates messages based on "geographic information" of a user's profile. For example, if the geographic information indicates a user is German, then the implicit language preference may be German. Because the geographic information is used, a user does not have to specify an explicit translation preference.

B.   Independent Claims on Appeal

1.   Claim 37

Claim 37 is directed to a method for translating instant messages exchanged between a first user using a first device and a second user using a second device over a communication network. The first user has a first translation preference and the second user has a second translation preference. (*See, e.g.,* Appellant's Published

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Application ¶¶ [0031]-[0034], Figures 5A and 5B ## 200, 214, 216, 250.) During initiation of an instant messaging session between the first device and the second device, the first device sends to the second device an indication of the first translation preference (*see, e.g., id.* ¶¶ [0024]-[0025], [0032]-[0034], Figure 3 ## 120, Figures 5A and 5B ## 200, 204, 214, 250), and the first device receives from the second device an indication of the second translation preference. (*See, e.g., id.* ¶¶ [0024]-[0025], [0032]-[0034], Figure 3, # 120, Figures 5A and 5B ## 200, 204, 216, 250.) The second translation preference is different from the first translation preference. (*See, e.g., id.* ¶¶ [0032]-[0034], Figures 5A and 5B ## 214, 216.) During the initiated session, the first device receives from the first user a first message intended for the second device, the first message composed according to the first translation preference. (*See, e.g., id.* ¶¶ [0032]-[0034], Figures 5A and 5B ## 200, 212, 214, Figure 7 # 400.) Based on the received indication of the second translation preference, the first device translates the received first message from the first translation preference to the second translation preference (*see, e.g., id.* ¶¶ [0032]-[0034], Figure 3 # 120, Figures 5A and 5B ## 200, 208, 212, 214, 216, 251, Figure 7 ## 404, 406), and transmits the translated message in the second translation preference to the second device as an instant message during the established session via the communication network. (*See, e.g., id.* ¶¶ [0032]-[0034], [0037], Figures 5A and 5B ## 200, 204, 208, 216, 218, 250, 251, Figure 7 # 408.)

2. Claim 42

Claim 42 is directed to a computer-readable medium having computer-executable instructions for performing the steps recited in claim 37. (*See, e.g.,* Appellant's Published Application ¶¶ [0024]-[0025], [0031]-[0034], [0037], Figure 3 # 120, Figures 5A and 5B ## 200, 204, 208, 212, 214, 216, 218, 250, 251, Figure 7 ## 400, 404, 406, 408.)

3.   <u>Claim 48</u>

Claim 48 is directed to a computing system of a first device for translating instant messages sent from a first user using the first device to a second user using a second device over a communication network. (*See, e.g.,* Appellant's Published Application ¶¶ [0025], [0031]-[0034], Figures 5A and 5B ## 200, 250.) The first user has a first translation preference and the second user has a second translation preference. (*See, e.g., id.* ¶¶ [0024]-[0025], [0032]-[0034], Figure 3 # 120, Figures 5A and 5B ## 200, 214, 216, 250.) The system includes a component of the first device that establishes an instant messaging session between the first device and the second device. (*See, e.g., id.* ¶¶ [0025], [0032]-[0034], Figures 5A and 5B ## 200, 204, 206, 250.) The system includes a component of the first device that, during the establishment of the instant messaging session, receives from the second device an indication of the second translation preference. (*See, e.g., id.* ¶¶ [0024]-[0025], [0032]-[0034], Figure 3 # 120, Figures 5A and 5B ## 200, 204, 206, 216, 250.) The second translation preference is different from the first translation preference. (*See, e.g., id.* ¶¶ [0032]-[0034], Figures 5A and 5B ## 214, 216.) The system includes a component of the first device that receives from the first user a first message intended for the second user, the first message composed according to the first translation preference (*see, e.g., id.* ¶¶ [0032]-[0034], Figure 3 # 120, Figures 5A and 5B ## 200, 204, 212, 214, 250, Figure 7 ## 400, 404), and that automatically translates the first message from the first translation preference to the second translation preference received during the establishment of the instant messaging session. (*See, e.g., id.* ¶¶ [0032]-[0034], Figures 5A and 5B ## 200, 208, 212, 214, 216, 218, 251, Figure 7 # 406.) The system includes a component of the first device that transmits during the established instant messaging session the translated message in the second translation preference to the second device via the communication network. (*See, e.g., id.* ¶¶ [0032]-[0034], Figures 5A and 5B ## 200, 204, 208, 216, 218, 251, Figure 7 # 408.) The system includes a component of the first device that receives from the second user a second message intended for the first user, the second message composed according to the second translation preference (*see,*

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e.g., id. ¶ [0034], Figure 5B ## 200, 204, 208, 214, 216, 250, 254), and that translates the second message from the second translation preference to the first translation preference. (*See, e.g., id.* ¶ [0034], Figure 5B ## 200, 208, 214, 216, 254.) The system includes a component of the first device that provides to the first user the second message translated to the first translation preference. (*See, e.g., id.* ¶ [0034], Figure 5B ## 200, 204, 208, 214, 254.)

4.   Claim 53

Claim 53 is directed to a method in a computer system for providing real-time communication over a network between first and second users. (*See, e.g.,* Appellant's Published Application ¶¶ [0024]-[0025], [0029], [0031]-[0034], Figure 4 ## 142, 144, Figures 5A and 5B ## 200, 250.) The method includes receiving first profile information from a first device of the first user, the profile information including first geographic information of the first user. (*See, e.g., id.* ¶¶ [0024]-[0026], [0032]-[0034], Figure 3 ## 100, 120, Figure 4 # 146, Figures 5A and 5B ## 200, 204.) The method includes receiving second profile information from a second device of the second user, the profile information including second geographic information of the second user. (*See, e.g., id.* ¶¶ [0024]-[0026], [0032]-[0034], Figure 3 ## 100, 120, Figure 4 # 148, Figures 5A and 5B ## 206, 250.) The method includes receiving from the first user a first message intended for the second user, translating the first message based on the first geographic information and the second geographic information, and providing the translated first message to the second user. (*See, e.g., id.* ¶¶ [0026]-[0029], [0032]-[0034], Figure 3 # 120, Figure 4 ## 142, 144, 146, 148, 154, 156, 162, 164, Figures 5A and 5B ## 200, 204, 206, 208, 212, 218, 250, 251, Figure 6 ## 306, 308, 310, Figure 7 ## 400, 404, 406, 408.) The method further includes receiving from the second user a second message intended for the first user, translating the second message based on the first geographic information and the second geographic information, and providing the translated second message to the first user. (*See, e.g., id.* ¶¶ [0026]-[0029], [0032]-[0034], Figure 3 # 120, Figure 4 ## 142, 144, 146, 148, 154, 158, Figures 5A and 5B ##

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200, 204, 206, 208, 250, 254, Figure 6 ## 306, 308, 310, Figure 7 ## 400, 404, 406, 408.)

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   Examiner's Rejections

The Examiner rejected claims 37-42 and 48-52 under 35 U.S.C. § 112, first paragraph.

The Examiner rejected claims 37-42 and 48-52 under 35 U.S.C. § 103(a) over a combination of Olivier (U.S. Patent No. 6,480,885), Trudeau (U.S. Patent No. 5,987,401), and Stringham (U.S. Publication No. 2002-0188670).

The Examiner rejected claims 53-58 under 35 U.S.C. § 103(a) over a combination of Olivier, Trudeau, Stringham, and Dietz (U.S. Patent No. 6,385,586).

B.   Issues on Appeal

1.   Section 112 Issues on Appeal

a.   Whether the claimed feature of "translating by the first device" is supported by the written description?

2.   Section 103(a) Issues on Appeal

a.   Whether Olivier and Trudeau, individually or in combination, describe a first device that both sends to a second device an indication of the first translation preference and receives from the second device an indication of the second translation preference?

b.   Whether the Examiner has provided a sufficient reason for combining Olivier and Trudeau?

c.   Whether Olivier, Trudeau, and Stringham, individually or in combination, disclose translation based on the received indication of the second translation preference?

d.   Whether the Examiner has provided a sufficient reason for combining Olivier, Trudeau, and Stringham?

e.   Whether the Examiner has provided a sufficient reason for combining Olivier, Trudeau, Stringham, and Dietz?

VII.   ARGUMENT

A.   Rejections Under 35 U.S.C. § 112, First Paragraph

1.   Appellant's specification clearly describes an embodiment in which translation is performed by a first device

The Examiner rejected claims 37-42 and 48-52 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner points to one section of appellant's specification in support of her position that the specification fails to describe that translation may be performed by a first device. The Examiner, however, overlooks another portion of appellant's specification that fully describes such a translation.

The Manual of Patent Examining Procedure ("M.P.E.P.") explains that, when a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention, the written description requirement is satisfied. (M.P.E.P. § 2163.) Indeed, all that is required to satisfy the written description requirement is "reasonable clarity." (M.P.E.P. § 2163.02.) Appellant's specification supports claims 37-42 and 48-52 with more than reasonable clarity.

In the final Office Action mailed May 7, 2008, the Examiner states that:

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> The amendment in which the translation is done by the first device is not shown in the specification or drawings. Figure 4 shows a content translation module (element 154) wherein the first device sends the information to the content translation module to be translated and the translated information in sent to the second device. It is not seen in the specification or drawings where the first device does the translation. The only part of the specification that comes close to the amendment is paragraph 0029 (referring to PGPUB 2003/0125927). It states that the content translation module may be located within the same network as the source or destination device, but that does not imply the first device does the translation. That only implies a system containing a combination of devices interconnected by telecommunication equipment or cables used to transmit or receive information, not that the actual first device does the translation.

(Office Action, May 7, 2008, pp. 2-3; emphasis added.) The Examiner is mistaken. Although paragraph [0029] might not describe such a translation, other portions of the specification do support it. For example, paragraphs [0032]-[0033] of appellant's published application clearly describe an embodiment of appellant's technology in which the translation is performed by "the first device." Paragraphs [0032]-[0033] disclose that a source device and a destination device initially exchange preferences. Each device has a content translation module to translate from the language of the device to the language of the other device. In particular, these paragraphs state that:

> The content translation module 208 resides on each of the devices and translates information from a source language to a destination language...
>
> ...[W]hen the destination language differs from the source language, the message is passed to the content translation module 208 for translation (event 404). The translation is performed using the translation preference information 120 (FIG. 3) exchanged by each of the devices during the initiation of the session. The content translation module 208 detects the preferences indicated in the user profile 100, converts the message to the destination language (event 406), and then transmits the newly translated message to the destination address (event 408).

(Appellant's Published Application ¶¶ [0032]-[0033]; emphasis added.) Thus, contrary to the Examiner's assertion, "the amendment in which the translation is done by the first

device" is fully supported by the specification. Moreover, one skilled in the art would reasonably conclude that appellant possessed the claimed invention based on appellant's express disclosure in the specification and drawings. Accordingly, appellant submits that the rejection of claims 37-42 and 48-52 under 35 U.S.C. § 112, first paragraph, should be reversed.

B.   Rejections Under 35 U.S.C. § 103(a)

1.   Legal Requirements for Obviousness

The Examiner has rejected claims 37-42 and 48-58 as being obvious under 35 U.S.C. § 103(a), which provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The Supreme Court has provided the following guidance in applying Section 103. In *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), the Court stated:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

More recently, the Supreme Court reaffirmed the holdings of *Graham* and clarified several aspects of the manner in which obviousness should be determined. (*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).) First, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," but "when the prior art teaches away from combining certain

known elements, discovery of a successful means of combining them is more likely to be nonobvious." (*Id.* at 1739-40.) Second, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"; rather, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *(Id.* at 1741.) The Court recognized that many significant advances will combine familiar elements: "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*Id.*)

Following the decision in *KSR Int'l*, the United States Patent and Trademark Office ("USPTO") issued a memorandum to all Examiners. The memorandum directs Examiners to continue to determine why a person of ordinary skill in the art would make the combination: "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." (USPTO Memorandum, *Supreme Court decision on KSR Int'l. Co. v. Teleflex, Inc.*, May 3, 2007, p. 2.)

Under these standards, appellant's invention would not have been obvious because the Examiner has not identified prior art references, or a combination thereof, that disclose all the elements of the pending claims. Moreover, the Examiner has not identified a sufficient reason to combine Olivier, Trudeau, Stringham, and Dietz. Therefore, the rejections of these claims should be reversed.

2. Cited References

a. Olivier

Olivier describes a technique for filtering subscribers of a mailing list into personalized subsets of the mailing list. (Olivier 3:8-32.) When a user sends an email

to a mailing list, Olivier describes that a server receives the email and determines which subscribers within the mailing list are to receive the email by comparing the sender's profile data against the acceptance criteria of each subscriber. (*Id.*) A sender's profile includes both a base user profile (e.g., name, address, email address, age, occupation) and a subscription user profile that contains information specific to the particular mailing list. (*Id.* 7:29-38.) As part of the subscription process, a subscriber specifies acceptance criteria data that is used to control with whom and about what topics the subscribers interact. (*Id.* 5:23-26, 7:15-38.) For example, a user may subscribe to a financial investment mailing list specifying that he only wishes to receive email about international mutual funds from other men age 40-50 within three miles of his office. (*Id.* 10:43-59.) Also, as part of the subscription process, a subscriber may specify a language preference. (*Id.* 17:28-39.) Olivier explains that "[a]t email distribution time, the email server uses an external language translation process to determine the message's language, [and] [f]or each user whose language preference doesn't match that language, the message is translated before being sent." (*Id.*)

Olivier explains that only subscribers of a mailing list may send email to the mailing list. (*Id.* 9:18-46, 10:28-42, 13:43-54.) However, a user, referred to as a "transient subscriber," may send an email to the mailing list by sending user profile data with the email. (*Id.* 10:28-42) Olivier explains that replies to a transient subscriber's email will reach the transient subscriber, but other messages to the mailing list will not. (*Id.*)

b.   Trudeau

Trudeau describes a technique for participating in a chat room in which the conversation language of the chat room is different from a user's language. (Trudeau 2:9-39, 10:22-28.) When the conversation language (e.g., Spanish) is not the same as the user's language (e.g., English), outgoing messages from the user are translated to the conversation language prior to being sent by the user's computer. (*Id.* 2:18-21, 10:36-42.) Likewise, incoming messages received in the conversation language are

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translated to the user's language by the user's computer. (*Id.* 2:35-38.) Trudeau explains that when a user initially logs onto a chat room, the user uses the "chat language selector" to select the chat language and uses the "user language selector" to select the user's language, such as English. (*Id.* 11:21-24, Figures 8A-8D.) According to Trudeau, when the language being utilized by the chat room is Spanish, the user selects Spanish as the chat language. (*Id.* 11:24-26, Figure 8A.) Then, when an incoming message is received in Spanish, it is translated by the user's computer into the user's language (e.g., English). (*Id.* Figures 8C, 8D.) Similarly, outgoing messages are translated by the user's computer into the conversation language (e.g., Spanish). (*Id.* Figures 8A, 8B.)

<p style="text-align:center">c.   <u>Stringham</u></p>

Stringham describes an email program for translating email messages. (Stringham ¶ [0016].) Stringham explains that the email program includes a database of correspondents of the user and that the database may include information identifying the language of each correspondent. (*Id.* ¶ [0017].) For each outgoing message, the language of the user is compared to the language of the correspondent. If the language of the user is different from the language of the correspondent, the message is translated by the email program and then forwarded to the correspondent. (*Id.* ¶ [0019].)

<p style="text-align:center">d.   <u>Dietz</u></p>

Dietz describes a speech recognition system for translating a user's native speech to text in a foreign language. (Dietz 2:45-49.) Dietz explains that "[t]he invention works by first capturing the speaker's native language. . . and converting it to a sound file of high fidelity" for "transmission to a more powerfully equipped server [with] a commercially available server-based speech recognition engine." (*Id.* 4:34-42.) Thus, with Dietz's system, a user may record speech in the user's native language (e.g., English) and then send to a server a request to translate the speech. According to

<p style="text-align:center">12</p>

Dietz, the foreign language may be selected based on global positioning (GPS) data received from the speech input device. (*Id.*) Dietz explains: "When a request is made from Brazil, a signal is sent back to the server indicating the geographical location of the signal. The server then accesses its database and determines that the native language is Portuguese, [and] the translated text is then presented to the user in Portuguese." (*Id.* 4:56-61.)

3.   Discussion of the Issues

a.   None of the cited references, alone or in combination, discloses or suggests a first device that both sends and receives a translation preference

Claims 37-42 recite "sending by the first device to the second device an indication of [a] first translation preference" and "receiving by the first device from the second device an indication of the second translation preference." It is the Examiner's position that the device of Olivier's transient subscriber corresponds to appellant's first device, which "send[s] . . . to the second device an indication of the first translation preference" as recited by claims 37-42. However, the Examiner recognizes that Olivier's transient subscriber device does not receive a language preference. (Office Action, May 7, 2008, p. 4.) To cure this deficiency, the Examiner relies on Trudeau. (*Id.* p. 5; citing Trudeau 3:66-4:52, 10:1-50.) Appellant disagrees. Trudeau does not disclose or suggest that *any* device sends a translation preference to any other device.[1]

Trudeau describes that a person who speaks one language can participate in a chat room in a different language with the help of the person's computer, which performs the translations between the user's language and the chat room language. In the relied-upon sections, Trudeau describes a chat room in which the conversation language is Spanish. (Trudeau 3:66-4:52, 10:1-50.) Trudeau explains that "certain

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[1] Moreover, the Examiner's position is unclear because the Examiner has not indicated whether the Examiner believes that it is Trudeau's chat room or a user device that corresponds to the recited first device that "receiv[es] . . . from the second device an indication of the second translation preference."

members are conversing directly in Spanish and others are conversing in English by way of [Trudeau's] translation technique." (*Id.* 4:23-15.) Using Trudeau's technique, "the English-speaking individual would type in an English message, and the message would be translated from English to Spanish and then sent" to the chat room. (*Id.* 4:13-20; emphasis added.) Likewise, "[w]hen the Spanish-speaking individual types in and sends a Spanish message, the Spanish message would be received by the computer of the English-speaking individual and then translated." (*Id.* 4:17-20; emphasis added.) Thus, the English-speaking individual's computer performs the translation from Spanish to English and from English to Spanish. As a result, there is no need for the English-speaking individual's computer to exchange language preferences with any other computer.

The Examiner concludes that "[e]ach device knows the other language because if the conference language is Spanish and the user language is English, then for an outgoing message, the appropriate language translator selected would be an English-to-Spanish translator." (Office Action, May 7, 2008, p. 5.) The Examiner appears to suggest that a chat room having a conversation language different from the user's language corresponds to receiving an indication of a second translation preference from another device. Appellant disagrees. In Trudeau, an indication of the conversation language is never received by a user's device from the chat room. Rather, Trudeau makes clear that it is the user, not the chat room, who provides an indication of the conversation language. In particular, Trudeau states that the user "make[s] language selections using the chat language selector . . . and the user language selector." (Trudeau 11:21-24.)

In addition, claims 37-42 recite "the second user having a second translation preference." The chat language, however, cannot be considered a translation preference of a user. Each user participating in the chat may actually prefer a language different from Spanish and use a translator to translate to and from their preferred

language. Thus, the chat language tells us nothing about the language that a user prefers.

b.   There is no reason to combine Olivier and Trudeau

The Examiner has not identified a sufficient reason for combining Olivier and Trudeau. To establish a prima facie case of obviousness, the Examiner must show that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." (*KSR Int'l Co.*, 127 S. Ct. at 1740-41.)

The Examiner suggests the following as the reason to combine Olivier and Trudeau:

> [I]t would have been obvious . . . to modify Olivier's method and system wherein it receives by the first device from the second device during the established session an indication of the second translation preference . . . to provide on-line services such that international, real-time, text-based conversations can be had between two or more users who themselves use different languages to converse.

(Office Action, May 7, 2008, pp. 5-6; emphasis added.) It is thus the Examiner's position that the reason to modify Olivier is to add the advantage of providing online services that allow users with different languages to converse. However, Olivier already allows subscribers with different languages to converse. Olivier's email server uses an "external language translation process" to translate from the language of a message to the language preference of each subscriber to the mailing list. (Olivier 17:28-35.) Moreover, Olivier already suggests that Olivier's technology can be applied to online services, such as an instant messaging service. (*Id.* 23:66-24:22.) In addition, Olivier explains that "[a]pplying the present invention to instant messaging requires no change to the subscription." (*Id.* 24:9-10.) So Olivier already has the advantage (i.e., translation for online services), the absence of which the Examiner suggests would motivate one to combine Olivier and Trudeau. Thus, one would have no reason to combine Olivier and Trudeau to achieve this advantage.

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c.   None of the cited references, alone or in combination, discloses or suggests a first device that translates a message from a first translation preference to a second translation preference based on a received indication of the second translation preference

Claims 37-42 recite "based on the received indication of the second translation preference, translating by the first device the received first message from the first translation preference to the second translation preference." Claims 48-52 recite "a component of the first device . . . that automatically translates the first message from the first translation preference to the second translation preference received during the establishment of the instant messaging session." It is the Examiner's position that Stringham's discussion at paragraphs [0016]-[0019] discloses "wherein the translation is done by the first device based on the received indication of the second translation preference." (Office Action, May 7, 2008, p. 6; emphasis added.) The Examiner is mistaken. In the relied upon sections, Stringham describes a database for "storing a translation preference by which the user may indicate whether the e-mail program shall translate e-mail messages" sent to a designated correspondent. (Stringham ¶ [0018].) However, nowhere does Stringham disclose that the stored language preference is received from the designated correspondent. Thus, appellant respectfully submits that Stringham does not disclose or suggest translating based on the received indication of the second translation preference.

d.   None of the cited references, alone or in combination, discloses or suggests a first device that exchanges translation preferences with a second device and that translates messages to and from the second translation preference of the second device

Claim 48 recites that devices exchange translation preferences and that a first device translates messages to and from the translation preference of the other device. As discussed above in Section VII(B)(3)(a), none of the references, alone or in combination, discloses or suggests exchanging translation preferences. Even assuming, for the sake of argument, that there was a suggestion to exchange

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translation preferences, it certainly would not have been obvious to have only one of the devices perform the translation of the messages after such an exchange. Rather, one skilled in the art would likely assume that, if translation preferences were exchanged, each of the devices would perform some translation. Otherwise, one device could simply send its translation preference to another device that is responsible for the translations without the other device sending its translation preference.

By exchanging translation preferences, appellant's technology allows one of the devices (e.g., if computationally powerful) to perform all the translation if the other device for some reason (e.g., it is not computationally powerful) does not perform any translation.

Moreover, the Examiner has failed to make a prima facie case of obviousness with respect to claims 48-52. The Examiner provides the same rationale for rejecting claims 37 and 48. (Office Action, May 7, 2008, pp. 4-6.) However, these claims are directed to different aspects of the invention. Claim 37 is directed to a first device that translates a message to a second translation preference before sending the translated message to a second device that indicated its preference was the second translation preference. Claim 48 recites the additional aspect that a component of a first device receives a message from a second user using a second device and translates the message from the second translation preference of the second user to the first translation preference of the first user. Thus, claims 37 and 48 recite the aspect that a message is translated by a sending device before sending, but claim 48 recites the additional aspect that a message is translated by a receiving device after it is received.

The Examiner has failed to point to where Olivier, Trudeau, or Stringham, individually or in combination, might describe a first device that receives a message composed according to the second translation preference, translates the message from the second translation preference to the first translation preference, and provides the translated message to the first user as recited by claims 48-52.

    e.   <u>There is no reason to combine Olivier, Trudeau, and Stringham</u>

The Examiner suggests the following as the reason to combine Olivier, Trudeau, and Stringham:

> [I]t would have been obvious . . . to modify Olivier in view of Trudeau . . . <u>to enable language translation the [sic] does not require a user to launch multiple software</u> [sic] (paragraph 0006).

(Office Action, May 7, 2008, p. 6; emphasis added.) It is thus the Examiner's position that the reason to modify Olivier and Trudeau is to add the advantage of not requiring a user to launch multiple software programs. Appellant disagrees. Neither Olivier nor Trudeau suggests requiring a user to launch multiple software programs to enable language translation, as suggested by the Examiner. For example, Olivier explains that, "[a]t email distribution time, the email server uses an external language translation process to determine the message's language. For each user whose language preference doesn't match that language, the message is translated before being sent." (Olivier 17:31-35.) Thus, Olivier does not require a user to launch multiple software programs to enable language translation. As another example, Trudeau explains that the user simply selects a "translate and send button 714" to translate and send a message. (Trudeau 11:1-67.) Thus, Trudeau does not require a user to launch multiple software programs to enable language translation. Accordingly, Olivier and Trudeau already have the advantage of language translation without requiring a user to launch multiple software programs, the absence of which the Examiner suggests would motivate one to combine Olivier, Trudeau, and Stringham. Thus, one would have no reason to combine Olivier, Trudeau, and Stringham to achieve this advantage. Moreover, such an advantage would not provide any motivation to combine Stringham's email program with Olivier and Trudeau since the advantage could be provided without such a combination.

f.   There is no reason to combine Olivier, Trudeau, Stringham, and Dietz

The Examiner suggests the following as the reason to combine Olivier, Trudeau, Stringham, and Dietz:

> [I]t would have been obvious . . . to modify Olivier in view of Trudeau and Stringham's system wherein it includes geographical information, as taught by Dietz, for providing a language translation environment on a data processing system to improve speech communication in foreign languages.

(Office Action, May 7, 2008, p. 8; emphasis added.) It is thus the Examiner's position that the reason to modify Olivier, Trudeau, and Stringham is to add the advantage of providing a system that uses language translation to improve communication in foreign languages. Appellant respectfully disagrees. Olivier already provides a system that uses a language translation process to translate messages that do not match the language preference of the recipient. (Olivier, 17:21-39.) Thus, Olivier already provides a "language translation environment . . . to improve speech communication in foreign languages," the absence of which the Examiner suggests would motivate one to combine Olivier, Trudeau, Stringham, and Dietz. Thus, one would have no reason to combine Olivier, Trudeau, Stringham, and Dietz to achieve this advantage. Moreover, such an advantage would not provide any motivation to combine Dietz's GPS technology with Olivier since the advantage could be provided without such use.

Moreover, even if the Examiner's assertion supports combining Olivier, Trudeau, Stringham, and Dietz, such a combination would entail complexities that would require detailed explanation for one of ordinary skill in the art to implement, which is not present in any of Olivier, Trudeau, Stringham, or Dietz. For example, although Olivier describes that a user may specify a location and geography of interest in the user's profile (Olivier 5:23-67), Olivier does not disclose or suggest that such location or geography of interest relates in any way to the user's translation preference. Olivier explains that such profile information is used to calculate matches between users to control with whom the user

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communicates. Thus, it is unclear how one of ordinary skill in the art would integrate the profile information described by Olivier with Dietz to produce the claimed invention.

4.   Discussion of the Rejections

a.   Claims 37-42

Claims 37-42 recite "sending by [a] first device to [a] second device an indication of the first translation preference, and receiving by the first device from the second device an indication of the second translation preference."   Claims 37-42 also recite "based on the received indication of the second translation preference, translating by the first device the received first message from the first translation preference to the second translation preference."   As discussed above in Sections VII(B)(3)(a) and VII(B)(3)(c), Olivier, Trudeau and Stringham, individually and in combination, fail to disclose a first device that transmits to a second device an indication of a first translation preference, receives from the second device an indication of a second translation preference, and translates a message from the first translation preference to the second translation preference based on the received indication of the second translation preference.   In addition, as discussed above in Sections VII(B)(3)(b) and VII(B)(3)(e), the Examiner has not provided a sufficient reason to combine Olivier, Trudeau, and Stringham.

b.   Claims 48-52

Claims 48-52 recite "a component of [a] first device that . . . receives from [a] second device an indication of the second translation preference . . . [and] a component of the first device . . . that automatically translates [a] first message from the first translation preference to the second translation preference received during the establishment of the instant messaging session."   As discussed above in Sections VII(B)(3)(a), VII(B)(3)(c), and VII(B)(3)(d), Olivier, Trudeau and Stringham, individually and in combination, fail to disclose a first device that receives from a second device an indication of a second translation preference and translates a message from a first

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translation preference to the second translation preference based on the received indication of the second translation preference. In addition, as discussed above in Sections VII(B)(3)(b) and VII(B)(3)(e), the Examiner has not provided a sufficient reason to combine Olivier, Trudeau, and Stringham.

c.   Claims 53-58

Claims 53-58 recite "receiving second profile information from a second device of the second user, the profile information including second geographic information of the second user . . . [and] receiving from the first user a first message intended for the second user, translating the first message based on the first geographic information and the second geographic information." As discussed above in Sections VII(B)(3)(a) and VII(B)(3)(c), Olivier, Trudeau, Stringham, and Dietz, individually and in combination, fail to disclose receiving geographic information and translating a message based on the received geographic information. In addition, as discussed above in Sections VII(B)(3)(b), VII(B)(3)(e), and VII(B)(3)(f), the Examiner has not provided a sufficient reason to combine Olivier, Trudeau, Stringham, and Dietz.

Moreover, the Examiner has failed to make a prima facie case of obviousness with respect to claims 53-58. Specifically, in rejecting claim 53, the Examiner stated:

> Regarding claim 53, it is interpreted and rejected for the same reasons as set forth in claim 37 and 48. In addition, Olivier in view of Trudeau and Stringham teach a translation system comprising a user profile (user profile) containing geographical information (Olivier; geography, column 5, lines 23-67), but does not specifically teach that the information is translated based on the geographic information. Dietz discloses a translation system wherein the translation is based on geographical information (column 4, lines 43-64), to determine what language the information needs to be translated into.

(Office Action, May 7, 2008, p. 7.) However, claim 53 recites:

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> A method in a computer system for providing real-time communication over a network between first and second users, the method comprising:
>
> . . .
>
> <u>receiving from the second user a second message intended for the first user, translating the second message based on the first geographic information and the second geographic information, and providing the translated second message to the first user.</u>

(Emphasis added.) In particular, the Examiner has not mentioned where Olivier, Trudeau, Stringham, or Dietz, individually or in combination, describe receiving from the second user a message intended for the first user and translating the message based on the first geographic information and the second geographic information. As such, the Examiner has failed to establish a prima facie case that claims 53-58 are obvious.

C.   Conclusion

Each of claims 37-42 and 48-58 has been improperly rejected in that (1) the claims are supported by the specification and drawings, (2) the Examiner has failed to provide prior art references that disclose all of the elements of the pending claims, and (3) the cited references would not support any rejection of these claims. Accordingly, appellant respectfully requests that the Examiner's rejection of claims 37-42 and 48-52 under 35 U.S.C. § 112, first paragraph, be reversed. In addition, appellant respectfully requests that the Examiner's rejection of claims 37-42 and 48-52 under 35 U.S.C. § 103(a) over a combination of Olivier, Trudeau, and Stringham be reversed. Appellant further respectfully requests that the Examiner's rejection of claims 53-58 under 35 U.S.C. § 103(a) over a combination of Olivier, Trudeau, Stringham, and Dietz be reversed.

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VIII.   <u>APPENDIX A</u>

37.   A method for translating instant messages exchanged between a first user using a first device and a second user using a second device over a communication network, the first user having a first translation preference and the second user having a second translation preference, the method comprising:

     during initiation of an instant messaging session between the first device and the second device,

         sending by the first device to the second device an indication of the first translation preference; and

         receiving by the first device from the second device an indication of the second translation preference, wherein the second translation preference is different from the first translation preference; and

     during the initiated session,

         receiving by the first device from the first user a first message intended for the second device, the first message composed according to the first translation preference;

         based on the received indication of the second translation preference, translating by the first device the received first message from the first translation preference to the second translation preference; and

         transmitting the translated message in the second translation preference to the second device as an instant message during the established session via the communication network.

38.   The method of claim 37 further comprising, storing by the first device the received indication of the second translation preference.

39.　　The method of claim 37 wherein the translation preference is specified as a destination language.

40.　　The method of claim 37 wherein the translation preference is specified as a locality.

41.　　The method of claim 37 wherein the translation preference is specified as a geographic setting.

42.　　A computer-readable medium having computer-executable instructions for performing the steps recited in claim 37.

48.　　A computing system of a first device for translating instant messages sent from a first user using the first device to a second user using a second device over a communication network, the first user having a first translation preference and the second user having a second translation preference, comprising:

　　a component of the first device that establishes an instant messaging session between the first device and the second device;

　　a component of the first device that, during the establishment of the instant messaging session, receives from the second device an indication of the second translation preference, wherein the second translation preference is different from the first translation preference;

　　a component of the first device that receives from the first user a first message intended for the second user, the first message composed according to the first translation preference, and that automatically translates the first message from the first translation preference to the second translation preference received during the establishment of the instant messaging session;

a component of the first device that transmits during the established instant messaging session the translated message in the second translation preference to the second device via the communication network;

a component of the first device that receives from the second user a second message intended for the first user, the second message composed according to the second translation preference, and that translates the second message from the second translation preference to the first translation preference; and

a component of the first device that provides to the first user the second message translated to the first translation preference.

49.   The computing system of claim 48 wherein the component that receives the indication of the second translation preference stores the received indication of the second translation preference.

50.   The computing system of claim 48 wherein the translation preference is specified as a destination language.

51.   The computing system of claim 48 wherein the translation preference is specified as a locality.

52.   The computing system of claim 48 wherein the translation preference is specified as a geographic setting.

53.   A method in a computer system for providing real-time communication over a network between first and second users, the method comprising:

receiving first profile information from a first device of the first user, the profile information including first geographic information of the first user;

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receiving second profile information from a second device of the second user, the profile information including second geographic information of the second user;

receiving from the first user a first message intended for the second user, translating the first message based on the first geographic information and the second geographic information, and providing the translated first message to the second user; and

receiving from the second user a second message intended for the first user, translating the second message based on the first geographic information and the second geographic information, and providing the translated second message to the first user.

54. The method of claim 53 wherein the first geographic information includes a locality of the first user.

55. The method of claim 53 wherein the computer system is the first device of the first user.

56. The method of claim 53 wherein the computer system is a server.

57. The method of claim 53 wherein the receiving of the first profile information and the receiving of the second message are performed at the second device and the receiving of the second profile information and the receiving of the first message are performed at the first device.

58. The method of claim 53 wherein the receiving of the first profile information and the second profile information occurs during initiation of a session for exchanging messages.

IX.   APPENDIX B

No evidence pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted.

X.   APPENDIX C

No related proceedings are referenced in Section II. above; hence, copies of decisions in related proceedings are not provided.